



188/167
Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

ANTHONY MAGLICA

Serial No. 07/411,576

Filed: September 22, 1989

For: FLASHLIGHT

Group Art Unit 291

Examiner M. Tung

Los Angeles, CA 90017

RECEIVED

SEP 02 1993

GRO: IP 2900

DECLARATION OF ROBERT C. WEISS

August 23, 1993

**Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231**

Sir:

I, Robert C. Weiss, do hereby state as follows:

1. Attached hereto as Exhibit A is a copy of a declaration of Paul Lawrence Gardner executed on March 3, 1988.
2. Attached hereto as Exhibit B is a copy of a declaration of Robert Kurt Wallor executed on March 18, 1988.
3. Attached hereto as Exhibit C is the transcript of the trial testimony of Paul Lawrence Gardner given on November 18, 1988 in the case of Kassnar Imports, Inc. v. Mag Instrument, Inc., CV86-0802-FFF in the United States District Court, Central District

#28

of California.

4. Attached hereto as Exhibit D are relevant pages of the deposition testimony of Paul Lawrence Gardner given on March 7, 1987 in connection with a proceeding before the United States International Trade Commission entitled In the Matter of Certain Small Aluminum flashlight and Compounds Thereof, Investigation No. 337-TA-254.

5. Attached hereto as Exhibit E is a copy of the drawing identified as Exhibit 2167 on page 11(A)-144 of Exhibit C and the drawing identified as K48980 on pages 103 and 104 of Exhibit D.

6. I am informed and believe that the person referred to on pages 68 and 69 as Mr. Walter is in fact Mr. Wallor and that Walter was a misspelling by the court reporter.

7. Attached hereto as Exhibit F is a copy of a declaration of Martin J. Siegel executed on September 29, 1992.

8. Attached hereto as Exhibit G is a copy of a declaration of Harold W. Jones executed on September 29, 1992.

9. Attached hereto as Exhibit H is a copy of a declaration of Jack V. Miller executed on September 30, 1992.

10. The shapes of the flashlight heads shown in the drawings attached as Exhibit B to the Siegel declaration, in the drawings attached as Exhibits A and B to the Jones declaration, in the drawings attached as Exhibit C to the Miller declaration and in

DECLARATION OF PAUL LAWRENCE GARDNER

I, the undersigned Paul Lawrence Gardner, hereby declare and state as follows:

1. I am an attorney licensed to practice law in the State of California and am registered to practice before the United States Patent and Trademark Office, Registration No. 22,372.

2. I am a shareholder in the law corporation of Spensley Horn Jubas & Lubitz, 1880 Century Park East, #500, Los Angeles, California 90067.

3. I specialize in the area of patent law; and Spensley Horn Jubas & Lubitz specializes in the areas of patent, trademark and related matters.

4. I represented Mr. Maglica and Mag Instrument, Inc. in connection with a number of patent applications during the year 1984, and earlier. One of those inventions was a small flashlight for which he requested the preparation of a patent application. That flashlight is illustrated on the drawings attached hereto, dated 7-23-84.

5. The small flashlight, its components, and one or more sketches of it were personally given to me by Mr. Maglica in connection with his request to me that I have a patent application prepared and filed in the U.S. Patent Office on this small flashlight. From the 7-23-84 date on the drawings (Exhibit A), I am confident that that meeting occurred prior to 7-23-84. It was my custom at that time to give sketches and prototypes of inventions to a patent draftsman for preparation of patent

EXHIBIT A

drawings, and the attached drawings appear to be drawings which I had prepared by a patent draftsman. Since the drawings are dated 7-23-84, I must have received the hardware and sketch or sketches from Mr. Maglica and delivered them to the patent draftsman prior to 7-23-84.

6. At no time during my representation of Mr. Maglica and Mag Instrument was I ever informed of any public use, disclosure, sale or offer for sale of any engineering model, prototype or commercial version of Mr. Maglica's small flashlight invention.

7. If I had been informed of any public use, public demonstration, disclosure, sale or offer for sale of any engineering model, prototype or commercial version of that invention, I would have taken all steps necessary to ensure that the application was prepared and filed with the U.S. Patent Office in advance of the one-year anniversary of such public use, disclosure, demonstration, sale or offer in order to ensure the validity of the patent that would issue therefrom. That is my practice, and it always has been so.

8. It is also my practice, and always has been, to explain to each new client who seeks patent protection that a public use, public disclosure, public demonstration, sale or offer for sale of an invention more than a year prior to the filing date of an application for a patent may render that invention unpatentable, pursuant to the provisions of 35 U.S.C. § 102. I believe that I

so informed Mr. Maglica of this fact, in that there would have been no reason for me to deviate from my normal practice of informing all clients of that fact.

9. At no time during my representation of Mag Instrument, Inc., did I have any information whatever from which I could have concluded that any engineering model, prototype or commercial version of the small flashlight disclosed to me by Mr. Maglica during the meeting referred to above, had been publicly used, publicly demonstrated, sold or offered for sale prior to September 6, 1984.

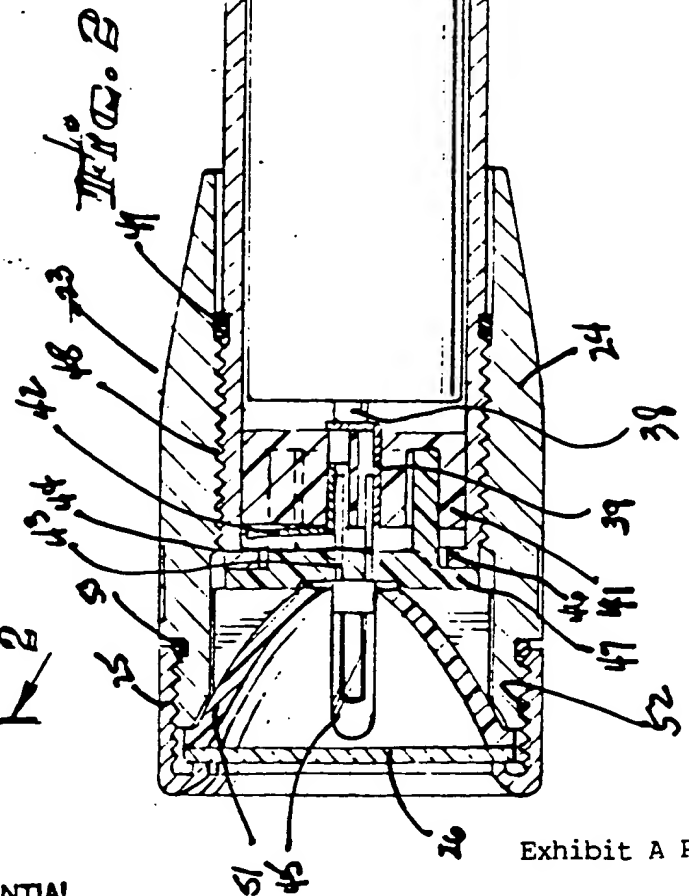
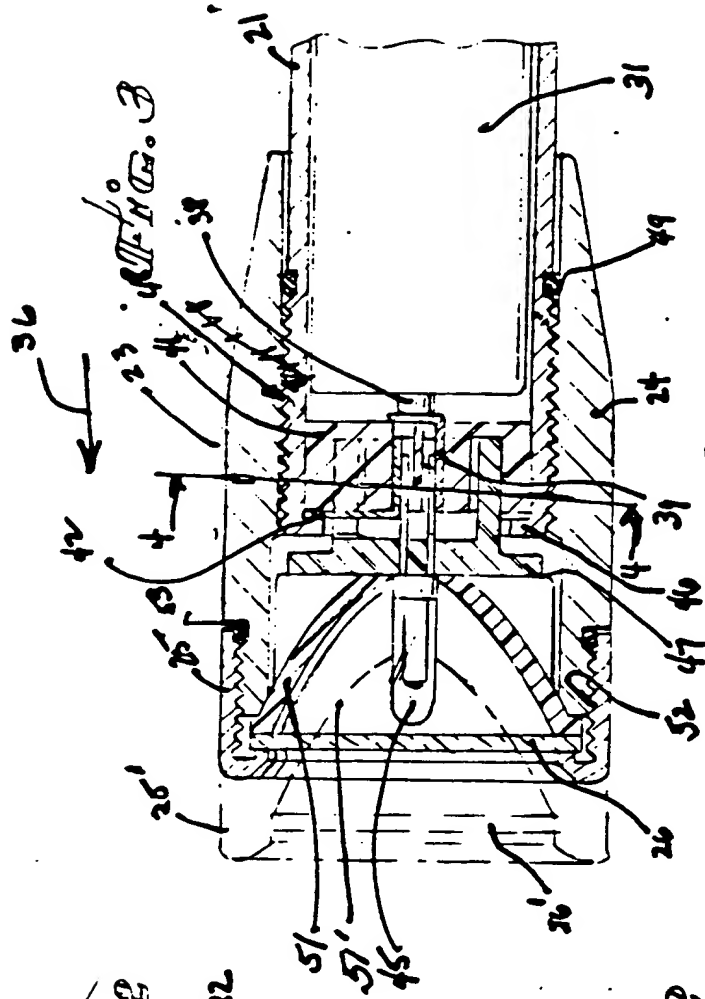
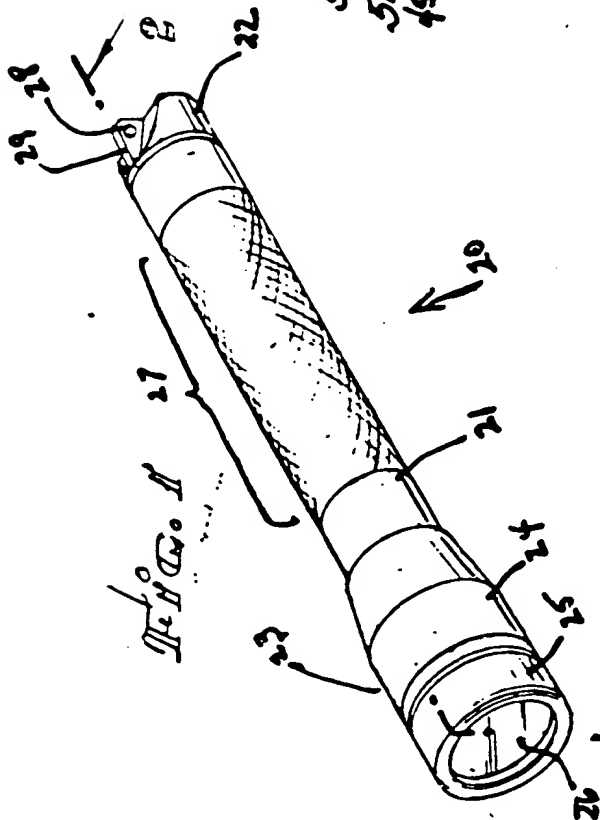
10. I am well aware of the requirements of candor and good faith in prosecuting applications for patents before the U.S. Patent and Trademark Office and I have been aware of these requirements, including 37 C.F.R. 1.56, since long before the time that I began to do work for Mr. Maglica and Mag Instrument. In prosecuting applications it has always been my practice to disclose all prior art which possibly might be considered to be material to the examination of the application; I always have erred on the side of providing prior art information which might be considered to be immaterial, rather than take the chance of failing to disclose prior art which might later be deemed to be material.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false

statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

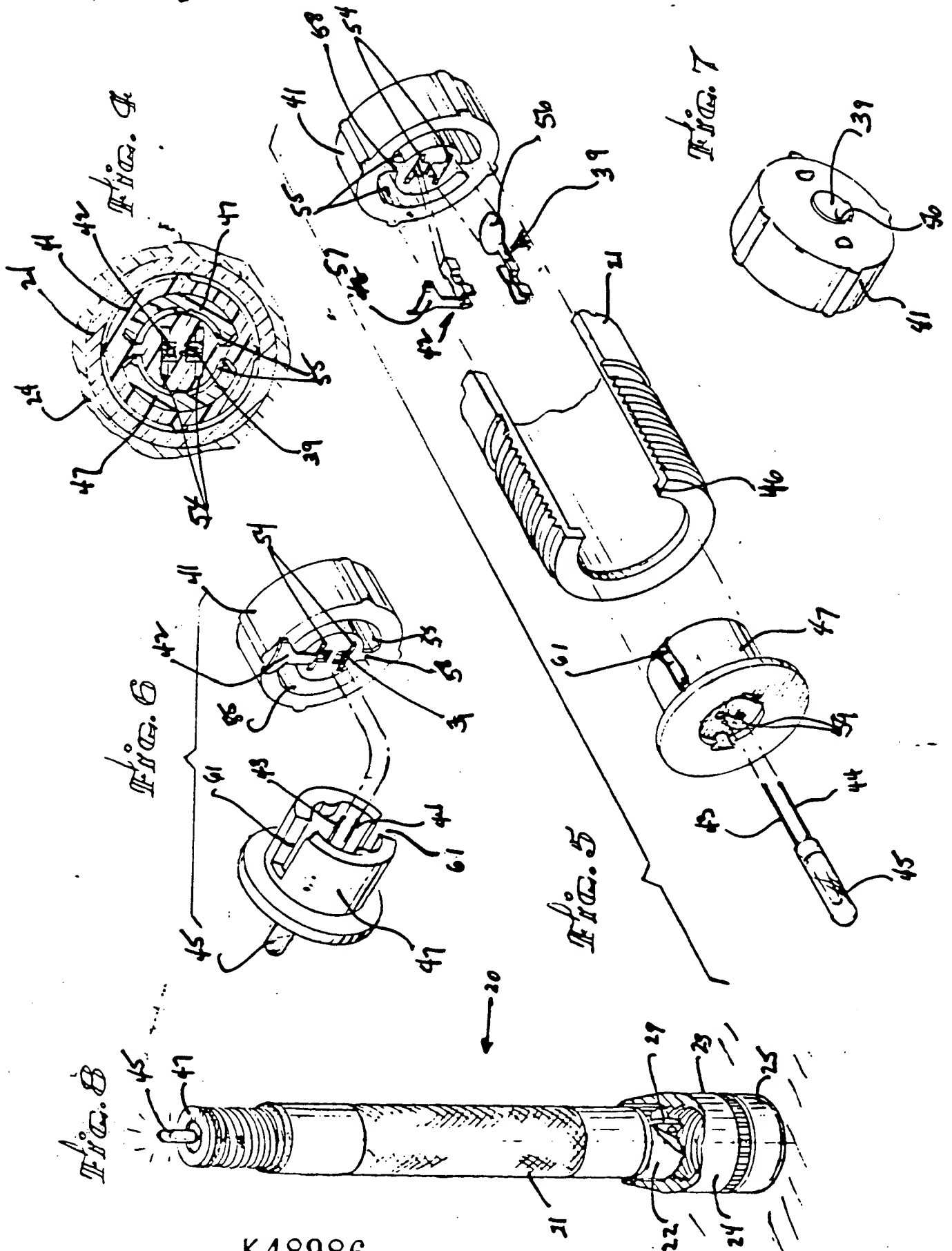
Executed at Los Angeles, California, this 3rd day of March, 1988.

Paul Lawrence Gardner
Paul Lawrence Gardner



K48985

Exhibit A Page 1



K48986

Exhibit A Page 2

MAG INSTRUMENT

CONFIDENTIAL
RESTRICTED BY COURT ORDER
MAG V. BRINKMANN

7-83-84 °

DECLARATION OF ROBERT KURT WALLOR

I, the undersigned Robert Kurt Wallor, hereby declare and state as follows:

1. I am an attorney licensed to practice law in the State of California, and am registered to practice before the United States Patent and Trademark Office, Registration No. 26,595.

2. I am presently in private practice in Muskegon, Michigan and I specialize in patent and related matters.

3. From approximately August 1, 1983 to approximately January 31, 1985, I was an associate at the firm of Spensley Horn Jubas & Lubitz at 1880 Century Park East, #500, Los Angeles, California 90067. At that time I worked primarily in the area of patent law and worked for, among others, Mr. Paul Gardner.

4. I recall having been instructed to prepare a patent application on a small flashlight invention for Mr. Anthony Maglica and Mag Instrument, Inc. by Mr. Paul Gardner. I recall that the invention was initially disclosed to me by Paul Gardner and that I was provided with various materials including one or more drawings and a sample flashlight. I believe that the disclosure to me was prior to July 23, 1984. The flashlight invention for which I prepared a patent application is illustrated in the drawings attached hereto, dated 7-23-84.

5. I recall that during my preparation of this application I made several telephone calls to Mr. Maglica and asked him several questions concerning the flashlight. I also recall that I met twice with Mr. Maglica regarding this application. The

EX. B

first time I met with Mr. Maglica was after I had prepared the draft application and when I reviewed it with him. I recall that during this meeting we discussed changes to be made which were to broaden the claims and some other changes which were minor in nature and which I do not now specifically recall. I recall that the second time I met with him was when I presented the finished application papers for his signature.

6. At no time during my employment at Spensley Horn Jubas & Lubitz was I ever informed of any public use, disclosure, sale or offer for sale of any engineering model, prototype or commercial version of Mr. Maglica's small flashlight invention by either Mr. Maglica or by Paul Gardner.

7. At no time during my employment with Spensley Horn Jubas & Lubitz and/or my work regarding preparation of a patent application concerning the small flashlight invention did I have any information whatever from which I could have concluded that any engineering model, prototype or commercial version of the small flashlight disclosed to me by Mr. Gardner and Mr. Maglica had been publicly used, publicly demonstrated, sold or offered for sale.

8. If I had been informed of any public use, public demonstration, disclosure, sale or offer for sale of any engineering model, prototype or commercial version of the small flashlight invention as early as August 14, 1983, I would have been able to and would have taken all steps necessary to ensure that the application was prepared and filed with the U.S. Patent

and Trademark Office in advance of the one-year anniversary of such public use, disclosure, demonstration, sale or offer for sale in order to ensure the validity of the patent that would issue therefrom.

9. I am confident that I could have completed and filed the patent application within a matter of a few days after the disclosure was originally made to me.

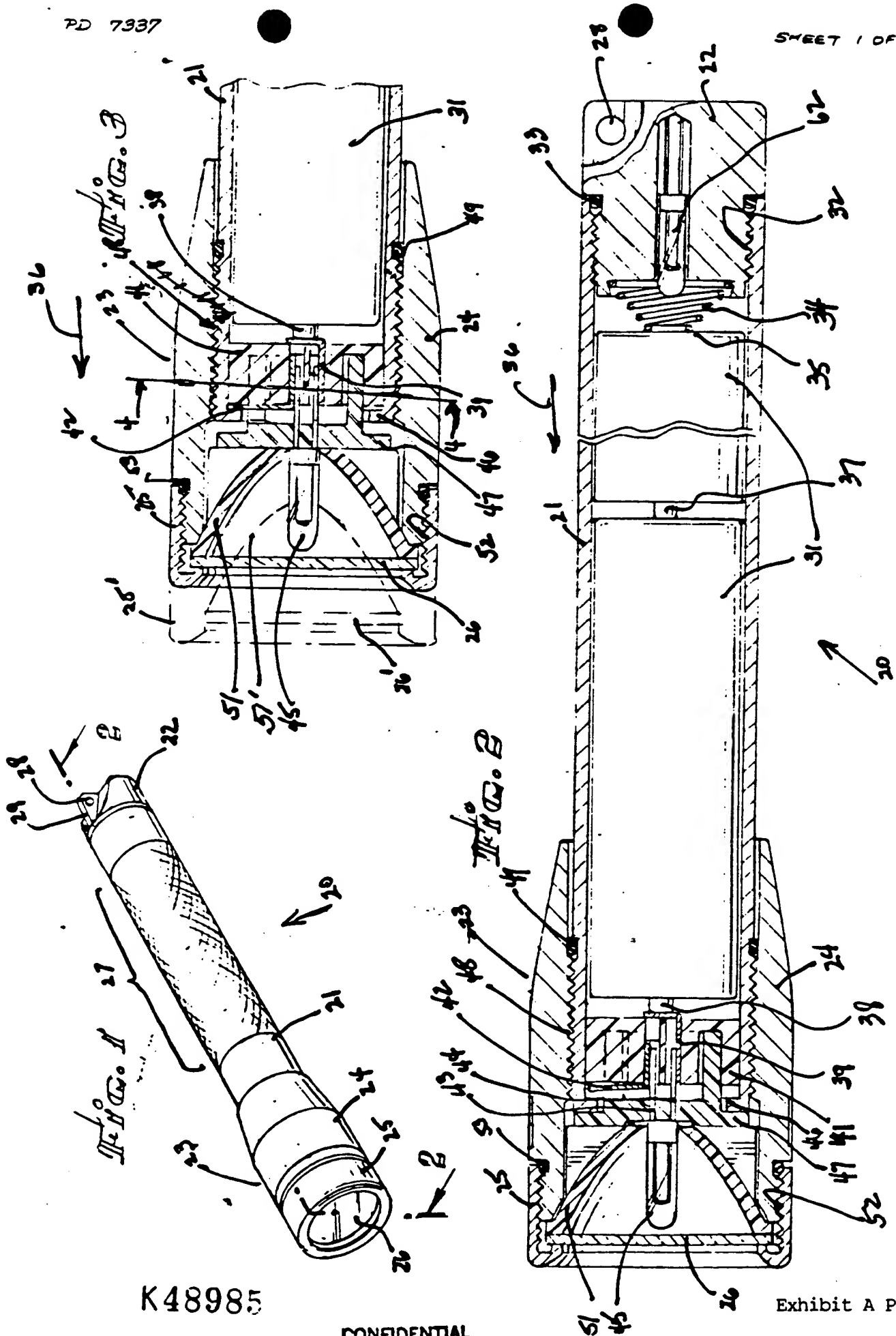
10. I am well aware of the requirements of candor and good faith in prosecuting applications for patents before the U.S. Patent and Trademark Office and I have been aware of these requirements, including 37 C.F.R. 1.56, since long before the time that I began to prepare the application for Mr. Maglica's small flashlight invention. It has always been my practice to disclose all prior art which possibly might be considered material to the examination of the patent application. I have always erred on the side of providing prior art information which might be considered to be immaterial, rather than to take the chance of failing to disclose prior art which might later be determined to be material.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that

these statements were made with the knowledge that willful false statements, and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Executed at Muskegon, Michigan, this 18th
day of March, 1988.

Robert Kurt Wallor
Robert Kurt Wallor

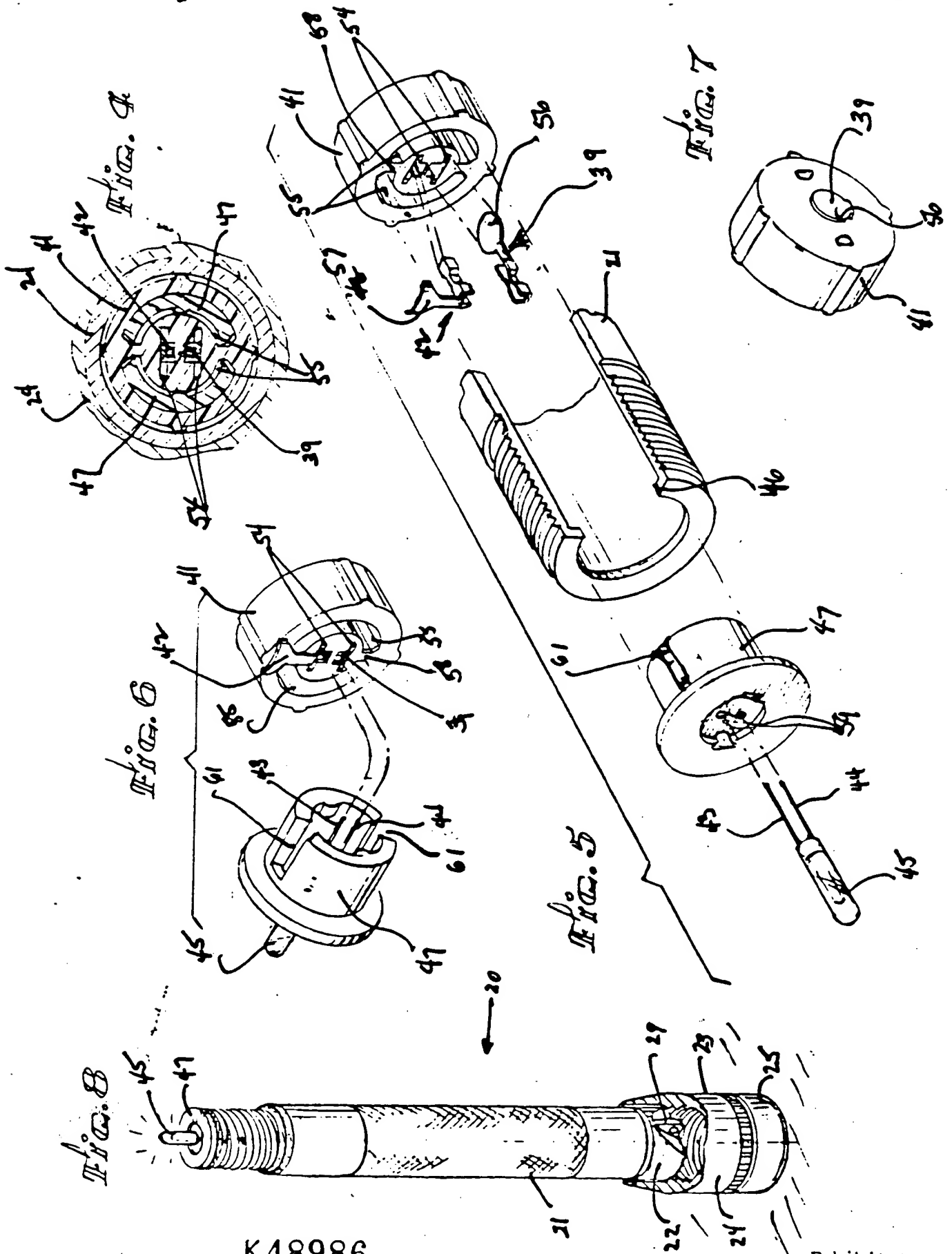


K48985

Exhibit A Page 1

CONFIDENTIAL
RESTRICTED BY COURT ORDER
MAG INSTRUMENT
MAG V. BRINKMANN

7-23-84



K48986

COPY

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

- - -

HONORABLE FERDINAND F. FERNANDEZ, DISTRICT JUDGE PRESIDING

- - -

KASSNAR IMPORTS, INC.,)	
)	
PLAINTIFF,)	CV 86-0802-FFF
)	
VS.)	DAY 11(A)
)	
MAG INSTRUMENT, INC.,)	
)	
DEFENDANT.)	
<hr/>		
MAG INSTRUMENT, INC.,)	
)	
COUNTERCLAIMANT,)	
)	
VS.)	
)	
KASSNAR IMPORTS, INC.,)	
)	
COUNTERDEFENDANT.)	
<hr/>		

REPORTER'S TRANSCRIPT OF OPEN COURT PROCEEDINGS

LOS ANGELES, CALIFORNIA

FRIDAY, NOVEMBER 18, 1988

SUSAN A. LEE, CSR 2800, CM, RPR
OFFICIAL COURT REPORTER
435 UNITED STATES COURTHOUSE
312 NORTH SPRING STREET
LOS ANGELES, CALIFORNIA 90012
(213) 626-6353

EX. C

1 THE COURT: MAY THIS WITNESS BE EXCUSED?

2 MR. WEISS: YES, YOUR HONOR.

3 MR. DINAN: I DON'T SUPPOSE I HAVE ANY CHOICE, YOUR
4 HONOR.

5 YOUR HONOR, WITH THE COURT'S INDULGENCE I WOULD LIKE
6 TO MAKE IT CLEAR ON THE RECORD THAT WE DID HAVE A NUMBER OF
7 LINES OF QUESTIONING WE HAVE WOULD HAVE ASKED THIS WITNESS HAD
8 WE HAD THE OPPORTUNITY, THE TIME OPPORTUNITY.

9 THE COURT: THE RECORD WILL REFLECT THAT.

10 THANK YOU, SIR. YOU MAY STEP DOWN.

11 THE WITNESS: THANK YOU.

12 THE COURT: BE CAREFUL OF THAT STEP.

13 THE WITNESS: THANK YOU.

14 MR. ANDERSON: YOUR HONOR, MAG INSTRUMENT CALLS PAUL
15 GARDNER TO THE STAND.

16 THE COURT: HE'S BEING CALLED ON --

17 MR. ANDERSON: HE IS BEING CALLED ON THE PATENT
18 REBUTTAL, YOUR HONOR.

19 THE COURT: ALL RIGHT.

20 THE CLERK: PLEASE RAISE YOUR RIGHT HAND TO BE SWORN

21

22 PAUL L. GARDNER + COUNTERCLAIMANT'S REBUTTAL WITNESS, SWORN

23

24 THE CLERK: PLEASE BE SEATED. PLEASE STATE YOUR FULL
25 NAME AND SPELL YOUR LAST NAME FOR THE RECORD.

1 THE WITNESS: PAUL LAWRENCE GARDNER, G A R D N
2 E R.

3 THE COURT: I SUPPOSE WE SHOULD NOTE FOR THE RECORD
4 THAT KASSNAR HAS RESTED.

5 MR. DINAN: I SUPPOSE WE SHOULD, YOUR HONOR. YOUR
6 HONOR, WE WOULD ALSO WOULD LIKE THAT THE RECORD REFLECT THAT
7 HAD WE TIME, WE WOULD HAVE CALLED TWO MORE WITNESSES.

8 THE COURT: LET'S SAY THIS: YOU'VE RSTED SUBJECT TO
9 GIVING ME ALL THE CAVEATS AND MOANS THAT YOU WOULD LIKE TO GIVE
10 ME AT A LATER TIME POINT.

11 MR. DINAN: OKAY.

12 THE COURT: OKAY? NOT BEING FORECLOSED FROM SO DOING.

13 MR. DINAN: ALL RIGHT. THANK YOU, YOUR HONOR.

14 MR. ANDERSON: MAY I BEGIN, YOUR HONOR?

15 THE COURT: YOU MAY.

16 DIRECT EXAMINATION +

17 BY MR. ANDERSON:

18 Q WHAT IS YOUR EDUCATIONAL BACKGROUND?

19 A I HAVE A BACHELOR'S DEGREE IN ENGINEERING FROM THE
20 UNIVERSITY OF MISSOURI IN 1962 AND A J.D. DEGREE FROM GEORGE
21 WASHINGTON UNIVERSITY IN 1965.

22 Q VERY BRIEFLY, WHAT DID YOU DO AFTER GRADUATING FROM LAW
23 SCHOOL?

24 A I WENT TO WORK AS A PATENT ATTORNEY FOR THE BOEING COMPANY
25 FOR THREE YEARS. AND THEN, SINCE 1968, I'VE BEEN IN THE

1 PRIVATE PRACTICE OF LAW, SPECIALIZING IN PATENTS, TO THE
2 PRESENT TIME.

3 Q HAVE YOU EVER REPRESENTED EITHER MR. MAGLICA OR MAG
4 INSTRUMENT?

5 A YES. I REPRESENTED MAG INSTRUMENT; AND MR. MAGLICA, AS I
6 UNDERSTOOD IT, WAS THE PRINCIPAL, IF NOT THE SOLE, SHAREHOLDER.

7 Q PLEASE TURN TO EXHIBIT 1171. IT'S IN WHITE BOOK EITHER 1
8 OR 2, I BELIEVE.

9 A I DON'T BELIEVE I HAVE IT IN FRONT OF ME.

10 MR. ANDERSON: I BELIEVE THEY'RE BEHIND YOU.

11 THE COURT: IT MAY BE BEHIND YOU. YOU WANT WHITE 1.

12 THE WITNESS: (LOCATES EXHIBIT.) YES, I HAVE IT.

13 BY MR. ANDERSON:

14 Q WHAT IS EXHIBIT 1171?

15 A IT'S A TRADEMARK SEARCH REPORT FROM THOMSON AND THOMSON ON
16 THE TRADEMARK "MINI-MAGLITE."

17 Q DO YOU RECOGNIZE THE RECEIVED STAMP ON THE FIRST PAGE OF
18 THIS DOCUMENT?

19 A YES, I DO.

20 Q WHAT IS IT?

21 A IT'S A STAMP OF THE FIRM I WAS WITH AT THE TIME, FULIP,
22 RALSTON, BURNS AND MC KITTRICK; THE TIME BEING AUGUST 18TH,
23 1980.

24 Q WHAT CLIENT REQUESTED THIS SEARCH?

25 A MAG INSTRUMENT OR MR. MAGLICA.

1 Q WHAT EXPERIENCE HAVE YOU HAD IN CONSULTING WITH CLIENTS
2 CONCERNING PREPARATION OF PATENT APPLICATIONS?

3 A WELL, SINCE I HAVE BEEN REGISTERED TO PRACTICE BEFORE THE
4 PATENT OFFICE, WHICH WAS IN ABOUT 1964 OR 1963, I'VE MET WITH A
5 LARGE NUMBER, RELATIVELY LARGE NUMBER, OF INVENTORS AND
6 COMPANIES DESIRING PATENTS; PROBABLY INTO THE HUNDREDS.

7 Q WHAT DO YOU NORMALLY DISCUSS WITH NEW CLIENTS WHO WANT FILE
8 FOR A PATENT?

9 A I NORMALLY HAVE DISCUSSED THE PROCEDURES AND REQUIREMENTS
10 FOR OBTAINING PATENT PROTECTION, INCLUDING THE REQUIREMENTS OF
11 NOVELTY AND UNOBVIOUSNESS.

12 Q DO YOU MAKE IT A PRACTICE TO DISCUSS THOSE THINGS WITH A
13 NEW CLIENT?

14 A YES, WITHOUT EXCEPTION.

15 Q DO YOU BELIEVE YOU EVER DISCUSSED THOSE WITH MR. MAGLICA?

16 A YES, I CERTAINLY DO.

17 Q PLEASE TURN TO EXHIBIT 2167 IN WHITE BOOK 3 BEHIND YOU.

18 A (SEARCHES FOR BINDER.) I'M SORRY. 2167, IN WHITE BOOK 2,
19 DID YOU SAY?

20 Q WHITE BOOK 3. I'M SORRY.

21 A YES, I HAVE IT.

22 Q WHAT IS THE FIRST PAGE OF EXHIBIT 2167?

23 A THE FIRST PAGE IS A FORM WHICH -- THE PRESENT FIRM THAT I'M
24 IN AND A SHAREHOLDER OF IS SPENSLEY, HORN, JUBAS AND LUBITZ,
25 AND -- THE FIRST PAGE IS THE FORM THAT WE USE WHEN A NEW

1 PATENT APPLICATION FILE IS OPENED.

2 Q WHO IS RUTH ONSTADT?

3 A RUTH ONSTADT WAS MY SECRETARY AT THE TIME THIS FORM WAS
4 PREPARED IN JULY OF 1984.

5 Q AND THAT WAS THE PURPOSE OF THIS FORM?

6 A TO START THE FILE. IT'S STANDARD OPERATING PROCEDURE.
7 THIS IS WAY THE FILE BEGINS: THIS IS CREATED.

8 Q IT'S CREATED THE DATE IT GIVES ON THAT DOCUMENT?

9 A YES.

10 Q AND WHAT SIGNIFICANCE, IF ANY, IS THERE TO THE JULY 8TH
11 1984 RECEIVED STAMP?

12 A JULY 5TH 1984?

13 Q I'M SORRY. YES.

14 A THAT IS THE DATE THAT EITHER -- WHEN THE SECRETARY ASKS THE
15 FILE CLERK TO ASSIGN A CLIENT NUMBER AND/OR A MATTER NUMBER TO
16 ANY NEW APPLICATION, THEY STAMP IT "RECEIVED" WHEN THAT IS
17 ACCOMPLISHED.

18 Q WHEN WOULD A FORM LIKE THIS BE FILLED OUT FOR WORK ON A
19 PATENT APPLICATION?

20 A ORDINARILY WHEN THE FILE IS BEGUN, AFTER THE REQUEST HAS
21 BEEN MADE TO PREPARE AND FILE AN APPLICATION.

22 Q WAS THIS FORM FILLED OUT AFTER YOU MET WITH MR. MAGLICA
23 CONCERNING FILING A PATENT APPLICATION ON A MINIATURE
24 FLASHLIGHT?

25 A YES.

1 Q WAS A PATENT APPLICATION PREPARED AFTER THIS FORM WAS
2 FILLED OUT?

3 A YES, IT WAS.

4 Q IDENTIFIED IN YOUR OFFICE BY: MATTER NO. 7337?

5 A YES, AS SHOWN ON EXHIBIT 2167.

6 Q PLEASE KEEP THAT DOCUMENT IN FRONT OF YOU, AND WE'LL BE
7 REFERRING BACK TO IT. BUT NOW TURN TO EXHIBIT 2881 IN WHITE
8 BOOK 5.

9 THE WITNESS: WHOOPS. (TRIPS ON STEP.)

10 THE COURT: WE ALMOST LOST ONE, AND A LAWYER.

11 COURTROOM: (LAUGHTER.)

12 MR. BEECHER: AND A LAWYER, TOO.

13 THE WITNESS: WHAT'S THE NUMBER AGAIN, PLEASE?

14 MR. ANDERSON: 2882.

15 THE WITNESS: I HAVE IT.

16 BY MR. ANDERSON:

17 Q WHAT IS EXHIBIT 2882?

18 A THIS APPEARS TO BE A COPY, REDUCED IN SIZE, OF THE FILE
19 HISTORY OF THE PATENT APPLICATION THAT'S IDENTIFIED ON THE
20 FRONT PAGE AS BEING TO MR. MAGLICA.

21 Q DOES IT HAVE A DOCKET NUMBER FROM YOUR OFFICE IN THIS FILE?

22 A ON THE THIRD PAGE, IN THE UPPER RIGHT-HAND CORNER IT SAYS:
23 CASE DOCKET NUMBER P D 7337. THAT'S OUR NUMBER, AND THAT'S
24 THE ONE SHOWN ON THE PREVIOUS EXHIBIT, 2167.

25 Q OKAY. NOW, PLEASE TURN TO THE PRINTS OF DRAWINGS AS

1 ORIGINALLY FILED IN THE MIDDLE OF THIS EXHIBIT.

2 A (COMPLIES.) YES.

3 Q WHEN WERE THOSE DRAWINGS PREPARED?

4 A FROM THE DATE ON THE BOTTOM THAT OUR PATENT DRAFTS -- IN
5 THIS CASE A WOMAN, A DRAFTSLADY, PUTS ON THE DRAWINGS AS A
6 MATTER OF COURSE: ABOUT JULY 23RD 1984.

7 THE COURT: WHICH EXHIBIT ARE WE LOOKING AT?

8 MR. ANDERSON: THAT WAS IN THE MIDDLE OF EXHIBIT 2882,
9 YOUR HONOR. THERE WERE TWO PAGES OF DRAWING.

10 THE COURT: FINE. I HAVE IT. THANK YOU.

11 BY MR. ANDERSON:

12 Q TURNING YOUR ATTENTION BACK TO EXHIBIT 2167 AND PAGE 3 OF
13 THAT EXHIBIT IN PARTICULAR --

14 A YES.

15 Q -- DO YOU HAVE THAT BEFORE YOU?

16 A YES.

17 Q WHAT IS IT?

18 A THIS IS A DRAWING THAT MR. MAGLICA GAVE TO ME WHEN WE MET
19 TO DISCUSS HIS REQUEST THAT A PATENT APPLICATION BE FILED.

20 Q DO YOU RECOGNIZE ANY HANDWRITING ON THIS?

21 A YES. THE WRITTEN -- THE WRITTEN WORD NEXT TO THE NUMBERS
22 AND ELSEWHERE ON THERE IS MY HANDWRITING.

23 Q WHEN DID YOU WRITE THAT, PUT YOUR HANDWRITING ON THE
24 DRAWING?

25 A I CAN'T GIVE YOU A DATE, BUT IT WAS AT THE TIME THAT MR.

1 MAGLICA AND I MET TO DISCUSS THE DETAILS FOR MY PREPARATION OR
2 MY HAVING THE PATENT APPLICATION PREPARED.

3 Q AND WHAT DID YOU DO WITH THAT DRAWING?

4 A THIS DRAWING HERE I GAVE TO -- FIRST GAVE TO THE PATENT
5 DRAFTSWOMAN - EVA IS HER NAME, RENKE (PHONETIC) - TO PREPARE
6 THE DRAWINGS.

7 Q NOW, ASSUMING THAT YOU KNEW THAT THE INVENTION DESCRIBED IN
8 THIS DRAWING WAS IN PUBLIC USE ON AUGUST 15TH 1983, HOW QUICKLY
9 COULD YOU HAVE HAD A PATENT APPLICATION PREPARED AND FILED IN
10 THE UNITED STATES PATENT OFFICE?

11 A I -- IF I HAD TO HAVE A PATENT APPLICATION ON FILE IN ORDER
12 TO MAKE SURE THAT IT WAS WITHIN THE ONE-YEAR PERIOD, I COULD
13 HAVE DONE IT, I BELIEVE, AND DISPATCHED IT TO THE PATENT
14 OFFICE, IN AS LITTLE AS A DAY. IF I HAD LONGER TIME, I MIGHT
15 HAVE TAKEN A FEW DAYS. BUT IF I HAD TO, I WOULD SAY WITHIN A
16 DAY.

17 Q OKAY. IF ON JULY 5, 1984, YOU KNEW OF A PUBLIC USE ON
18 AUGUST 15, 1983, WOULD YOU HAVE WAITED UNTIL SEPTEMBER 6, 1984,
19 TO FILE A PATENT APPLICATION ON THE INVENTION?

20 A OF COURSE NOT. UNEQUIVOCALLY, NO.

21 MR. ANDERSON: NO FURTHER QUESTIONS, YOUR HONOR.

22 THE COURT: THAN YOU FOR TESTIFYING, SIR.

23 MR. DINAN: YOUR HONOR, CAN I BRING SOMETHING TO THE
24 COURT'S ATTENTION? WHEN YOU ASKED IF I RESTED AND I STARTED TO
25 MOAN, WE DID HAVE A COUPLE OF THINGS THAT WE DID WANT TO MOVE

SUPERIOR COURT OF THE STATE OF CALIFORNIA
FOR THE COUNTY OF LOS ANGELES

IN THE MATTER OF

CERTAIN SMALL ALUMINUM
FLASHLIGHT AND COMPONENTS
THEREOF

)
) INVESTIGATION NO. 337-TA-254
)
)
)

DEPOSITION OF: PAUL GARDNER

TAKEN ON: MARCH 7, 1987

Certified Copy

P E L L E T I E R & J O N E S
3200 WEST THIRD STREET
LOS ANGELES, CALIFORNIA 90020
(213) 380-5077 (714) 641-8451

REPORTED BY:

MICHELLE PULTZ, CSR #4409

FILE NO.: 7-1520

EX. D

1 ON PATENT LAW?

2 A THE FEDERAL CIRCUIT OPINIONS, SLIP SHEETS,
3 AND, OF COURSE, IN CONNECTION WITH THE WORK THAT I DO I'M
4 READING OPINIONS ALL THE TIME. I READ THE PERIODICALS
5 THAT ARE CIRCULATING IN OUR OFFICE LIKE THE Y.P.O.S., THE
6 B.F.A. SHEETS, U.S.P.Q. I CAN'T RECALL THE NAMES OF THE
7 OTHERS.

8 THERE'S A VARIETY OF THE LITERATURE THAT GOES
9 BY ME, ACROSS MY DESK, AND I LOOK AT IT OR NOT DEPENDING
10 ON WHETHER I HAVE AN INTEREST WHAT'S IN THERE, AND TIME
11 IS ALSO A CONSIDERATION.

12 Q NOW, OTHER THAN WHAT YOU MAY HAVE LEARNED
13 DURING THE COURSE OF YOUR REPRESENTATION OF ANTHONY
14 MAGLICA OR MAG INSTRUMENT, DO YOU HAVE ANY PERSONAL
15 EXPERIENCE OR BACKGROUND IN FLASHLIGHT DESIGN?

16 A NO.

17 Q DO YOU OWN ANY FLASHLIGHTS?

18 A YES.

19 Q DO YOU KNOW WHO'S THE MAKER OF THOSE
20 FLASHLIGHTS?

21 A MAG INSTRUMENT IS THE ONLY NAME THAT I'M
22 FAMILIAR WITH IN FLASHLIGHTS.

23 Q DO YOU OWN SOME MAG INSTRUMENT FLASHLIGHTS?

24 A YES.

25 Q WHICH ONES, DO YOU KNOW?

1 A NO -- I MEAN IF YOU ASK ME THE MODEL NUMBERS,
2 NO. I HAVE A SMALL ONE AND TWO LARGE ONES.

3 Q DO YOU KNOW THE SMALL ONE BY THE NAME
4 MINI-MAGLITE?

5 A YES.

6 Q AND THE LARGE ONES BY THE NAME MAGLITE?

7 A YES.

8 Q HOW DID YOU COME BY THOSE FLASHLIGHTS?

9 A MR. MAGLICA GAVE THEM TO ME.

10 Q DO YOU OWN A MAG CHARGER FLASHLIGHT?

11 A NO.

12 Q DO YOU KNOW WHAT A MAG CHARGER FLASHLIGHT IS?

13 A I DON'T KNOW WHAT YOU MEAN BY THAT. MY
14 RECOLLECTION IS THAT I OR SOMEBODY THAT I ASSIGNED TO IT
15 DID SOME WORK ON A PATENT FOR A FLASHLIGHT CHARGER, AND
16 I ASSUME IT'S THE FLASHLIGHT THAT'S COMPATIBLE WITH THE
17 CHARGER.

18 Q THE FLASHLIGHT I AM REFERRING TO, I BELIEVE,
19 IS SHOWN ON THE REVERSE SIDE OF THE SMALL 'N MIGHTY
20 LITERATURE THAT WAS PRODUCED TO US THIS MORNING.

21 A I DON'T OWN THAT LIGHT.

22 Q NOW, EVEN THOUGH YOU NO LONGER GET INVOLVED
23 IN THE DETAIL WORK OF DRAFTING PATENT APPLICATIONS, DO
24 YOU STILL MEET WITH CLIENTS TO RECEIVE INVENTION
25 DISCLOSURES AND COUNSEL THEM ON WHETHER OR NOT IT'S

(WHEREUPON THE EXHIBIT WAS
MARKED AS BRINKMANN'S 152
BY THE NOTARY PUBLIC AND
RETAINED BY COUNSEL.)

Q FOR THE RECORD, BRINKMANN'S 152 COMPRISES A
COVER LETTER DATED MARCH 2, 1987 FROM THE FIRM OF LYON
& LYON TO THE FIRM PRETTY, SCHROEDER, BRUEGGEMANN & CLARK
AND ATTACHED THERETO IS A TWO-PAGE PRIVILEGED SCHEDULE
WHICH I'M REPRESENTING TO YOU, MR. GARDNER, RELATES TO
CORRESPONDENCE CONCERNING U.S. PATENT NO. 457263 ON
THE MINI-MAGLITE FLASHLIGHT.

I WOULD ASK YOU TO LOOK AT THAT PRIVILEGED
SCHEDULE WHICH REFLECTS AT LEAST WHAT APPEARS TO BE THREE
OR FOUR LETTERS FROM YOU OR SOMEONE AT YOUR FIRM TO
ANTHONY MAGLICA RELATED TO THIS MATTER AND ASK IF THE
DATES OF THOSE LETTERS IN ANY WAY REFRESH YOUR RECOLLECTION
AS TO WHEN YOU FIRST BECAME AWARE OF THE MINI-MAGLITE
FLASHLIGHT?

A NO, THEY DON'T.

Q DO YOU RECALL HOW YOU FIRST BECAME AWARE OF
THE MINI-MAGLIGHT FLASHLIGHT?

A I DON'T RECALL WHEN I FIRST OR THE
CIRCUMSTANCES OF MY FIRST AWARENESS, SO I CAN'T TELL YOU
THAT.

MY FIRST RECOLLECTION OF IT IS BEING GIVEN

1 SOME INFORMATION FROM MR. MAGLICA. I DON'T EVEN RECALL
2 WHAT THE INFORMATION WAS, WHETHER IT WAS IN THE FORM OF
3 WRITTEN INFORMATION OR ONLY ORAL INFORMATION OR HARDWARE.
4 I DON'T REMEMBER HOW IT WAS ACCOMPLISHED THE FIRST TIME.

5 MR. CLARK: OFF THE RECORD.

6 (WHEREUPON A DISCUSSION WAS
7 HELD OFF THE RECORD.)

8 (WHEREUPON THE EXHIBIT WAS
9 MARKED AS BRINKMANN'S 153
10 BY THE NOTARY PUBLIC AND
11 RETAINED BY COUNSEL.)

12 MR. CLARK: FOR THE RECORD, BRINKMANN'S 153 IS A
13 SET OF PAPERS WHICH HAVE BEEN BASE NUMBERED IN PRODUCTION
14 AS K48977 THROUGH K48994 INCLUSIVE, AND THEY ARE ALL
15 MARKED CONFIDENTIAL RESTRICTIVE BY COURT ORDER, MAG VS.
16 BRINKMANN.

17 OFF THE RECORD MR. WEISS INDICATED TO ME THAT
18 HE HAD NO OBJECTION TO ME SHOWING THESE DOCUMENTS TO
19 MR. GARDNER; IS THAT CORRECT, MR. WEISS?

20 MR. WEISS: CORRECT.

21 Q BY MR. CLARK: MR. GARDNER, I WILL HAND YOU
22 EXHIBIT 153 AND ASK YOU TO REVIEW IT FOR THE PURPOSE OF
23 DETERMINING WHETHER ANY OF THESE DOCUMENTS REFLECT ANY
24 MEETING YOU HAD WITH MR. MAGLICA PRIOR TO THE TIME THAT
25 AN APPLICATION FOR THE MINI-MAGLITE PATENT APPLICATION

1 Q DO YOU RECALL WHERE IN HIS PLANT YOU MET WITH
2 HIM?

3 A AS I RECALL, IT WAS IN VARIOUS PLACES
4 BECAUSE HE TOOK ME ON A TOUR AT THAT TIME. IT WAS ON A
5 SATURDAY.

6 Q WAS THAT THE FIRST TIME YOU HAD EVER BEEN
7 TO THIS PLANT?

8 A I DON'T KNOW. I WAS ONLY THERE ONE, TWO
9 OR THREE TIMES, AND I DON'T KNOW IF IT WAS ON THE SAME
10 OCCASION. THE FIRST TIME I WAS THERE HE SHOWED ME
11 AROUND AND I DON'T RECALL IF THAT WAS THE OCCASION THAT
12 WE SPOKE ABOUT THIS OR NOT.

13 Q ON THE ONE OCCASION THAT YOU RECALL RELATING
14 TO THE PATENT APPLICATION FOR THE MINI-MAGLITE FLASHLIGHT,
15 HOW LONG DID YOU MEET WITH MR. MAGLICA ON THAT SUBJECT?

16 A I'M GOING TO HAVE TO QUALIFY THAT LAST
17 ANSWER.

18 I'M NOT REALLY SURE. I'M REALLY NOT SURE I
19 DID MEET WITH HIM AT HIS PLANT ON THE MINI-MAG. I'M
20 JUST NOT SURE. MY THOUGHT PROCESS IS I HAVE A VAGUE
21 RECOLLECTION AND I MAY STILL HAVE BEEN WITH FULOP AND
22 HARDY AND THAT WOULD HAVE BEEN IN '82, BUT I COULD BE
23 WRONG.

24 Q WELL, MAYBE WE OUGHT TO BACKTRACK. DO YOU
25 RECALL ANY MEETING PRIOR TO SEPTEMBER 6, 1984 WITH

1 MR. MAGLICA CONCERNING A PATENT APPLICATION FOR THE
2 MINI-MAGLITE?

3 A I RECALL THAT THERE WAS ONE, BUT I'M NOT
4 SURE WHERE IT WAS. I'M NOT SURE THAT IT WAS OUT AT HIS
5 PLANT.

6 Q DO YOU RECALL --

7 A IT COULD HAVE BEEN, AND IT COULD NOT HAVE
8 BEEN. I DON'T REMEMBER.

9 Q DO YOU RECALL WHO WAS PRESENT AT THAT
10 MEETING?

11 A YES, JUST -- HE WAS THERE AND I WAS THERE
12 AND THAT WAS IT.

13 Q DO YOU RECALL HOW LONG THAT MEETING LASTED?

14 A NO.

15 Q DO YOU RECALL WHETHER HE SHOWED YOU A
16 MINI-MAGLITE FLASHLIGHT ON THAT OCCASION?

17 A HE DID SHOW ME A MINI-MAG FLASHLIGHT. HE
18 DID SHOW ME PARTS TO A MINI-MAG FLASHLIGHT. WHETHER
19 IT WAS COMPLETED OR NOT I DON'T KNOW. WHETHER IT WAS ON
20 THAT OCCASION OR NOT I DON'T KNOW. I DON'T KNOW WHETHER
21 I SAW THE HARDWARE FIRST OR THE DRAWINGS FIRST.

22 Q DO YOU RECALL WHETHER HE GAVE YOU A MINI-
23 MAGLITE FLASHLIGHT OR PARTS FOR SUCH A FLASHLIGHT TO
24 RETAIN?

25 A YES.

1 THE WITNESS: IS THERE A QUESTION PENDING?

2 MR. CLARK: NO. JUST SO THE RECORD IS CLEAR, I
3 BELIEVE I HAD ASKED YOU WHAT PHYSICAL DEVICES OR PARTS OF
4 PHYSICAL DEVICES MR. MAGLICA HAD PROVIDED TO YOU.

5 THE WITNESS: IN ORDER TO PREPARE THE APPLICATION?

6 Q BY MR. CLARK: YES. I UNDERSTAND THAT IS
7 BEING OBJECTED TO.

8 A NO, IT HAS NOT BEEN.

9 Q I WILL REFRAME THE QUESTION AGAIN.

10 IN YOUR MEETING MR. MAGLICA REGARDING THE
11 PREPARATION OF A PATENT APPLICATION ON A MINI-MAGLITE
12 FLASHLIGHT, WHAT PHYSICAL ITEMS DID HE PROVIDE YOU FOR
13 THAT PURPOSE?

14 A FOR THE PURPOSE OF PREPARING THE APPLICATION?

15 Q YES.

16 A HE GAVE ME SOME HARDWARE OF THE MINI-MAGLITE
17 OR WHAT WAS TO BE A MINI-MAGLITE, TO MY RECOLLECTION, AND
18 ONE OR TWO DRAWINGS, TO MY RECOLLECTION.

19 Q DO YOU RECALL WHETHER THE HARDWARE WAS A
20 COMPLETED AND ASSEMBLED MINI-MAGLITE FLASHLIGHT?

21 A NO, I DON'T RECALL.

22 Q DO YOU RECALL WHETHER THE HARDWARE INCLUDED
23 INDIVIDUAL PARTS FOR WHAT YOU UNDERSTOOD TO BE A
24 MINI-MAGLITE FLASHLIGHT?

25 A THERE WERE PARTS AND THEY FIT TOGETHER, AND

1 WHETHER THEY WOULD HAVE MADE A COMPLETE ITEM OR NOT, I
2 DON'T RECALL.

3 FOR EXAMPLE, I DON'T REMEMBER IF A PIECE OF
4 GLASS WAS THERE. HE GAVE ME WHAT -- HE GAVE ME, FOR THE
5 PURPOSE OF PREPARING THE APPLICATION -- HE MAY HAVE LEFT
6 SOME PIECES OUT.

7 Q AT THE TIME OF THE MEETING, DID YOU HAVE AN
8 UNDERSTANDING AS TO WHETHER OR NOT THE MINI-MAGLITE
9 FLASHLIGHT HAD BEEN INTRODUCED INTO THE MARKETPLACE YET?

10 MR. WEISS: I'M GOING TO OBJECT TO THAT QUESTION.
11 PERHAPS YOU CAN GET AT IT SOME OTHER WAY, BUT THE WAY
12 IT'S STATED NOW, IT SEEMS TO ME MAY REQUIRE THE WITNESS TO
13 DIVULGE A COMMUNICATION BETWEEN HE AND MR. MAGLICA.

14 Q BY MR. CLARK: AT THE TIME OF THIS MEETING
15 WITH MR. MAGLICA, WERE YOU INDEPENDENTLY AWARE OF THE
16 EXISTENCE OF A MINI-MAGLITE FLASHLIGHT ON THE MARKET?

17 A I DON'T THINK SO. I'M GOING TO HAVE
18 DIFFICULTY WITH JUST REMEMBERING THE SEQUENCE OF EVENTS.

19 I DON'T THINK SO, BUT I DON'T KNOW. IF YOU'RE
20 ASKING ME HAD I SEEN ONE IN THE MARKETPLACE, THE ANSWER IS
21 DEFINITELY NO.

22 Q DO YOU RECALL IN YOUR MEETING OR MEETINGS
23 WITH MR. MAGLICA PRIOR TO FILING THE PATENT APPLICATION,
24 THAT YOU DISCUSSED THE SUBJECT OF WHETHER OR NOT THE
25 MINI-MAGLITE FLASHLIGHT HAD BEEN INTRODUCED TO THE

1 A IF YOU WANT ME TO TAKE THE TIME TO READ THE
2 SPECIFICATION, I WILL DO SO. I CAN'T TELL YOU. I
3 HAVEN'T READ THE SPECIFICATION IN A LONG TIME.

4 I DON'T REMEMBER WHAT'S IN THERE ABOUT BIPIN
5 BULBS.

6 DO YOU WANT ME TO TELL YOU WHAT'S NOT IN
7 THERE THAT I KNOW ABOUT THEM THAT I GOT FROM MR. MAGLICA?

8 I HAVE TO READ THE APPLICATION.

9 Q LET ME ASK YOU SOME OTHER QUESTIONS FIRST.

10 NOW, IS IT TRUE THAT THE INFORMATION THAT
11 MR. MAGLICA PROVIDED TO YOU FOR PURPOSES OF PREPARING
12 A PATENT APPLICATION ON THE MINI-MAGLITE FLASHLIGHT WAS
13 TURNED OVER TO A MR. WALTER OF YOUR FIRM?

14 A THAT'S CORRECT.

15 Q DID YOU TURN OVER TO MR. WALTER ALL
16 INFORMATION ABOUT THE MINI-MAGLITE FLASHLIGHT WHICH
17 MR. MAGLICA PROVIDED TO YOU?

18 A I TURNED OVER TO HIM ALL TANGIBLE INFORMATION
19 AND I GAVE HIM -- I REPEATED THE ORAL -- THE INFORMATION
20 I RECEIVED ORALLY THAT I THOUGHT WAS APPROPRIATE.

21 IN OTHER WORDS, WHAT I THOUGHT WAS NECESSARY
22 FOR HIM TO PREPARE THE APPLICATION PROPERLY.

23 Q DO I UNDERSTAND CORRECTLY THEN THAT IN
24 TRANSFERRING INFORMATION TO MR. WALTER THAT YOU FILTERED
25 OUT INFORMATION THAT MR. MAGLICA GAVE YOU THAT YOU FELT

1 WAS NOT APPROPRIATE OR NECESSARY TO INCLUDE IN THE PATENT
2 APPLICATION?

3 A WELL, GENERALLY THAT'S TRUE. I OBJECT TO
4 THE -- THE PROBLEM I HAVE WITH THE QUESTION IS FILTERED
5 OUT.

6 I DIDN'T FILTER OUT ANYTHING. I DIDN'T
7 WITHHOLD ANYTHING. I DIDN'T TELL HIM EVERYTHING I KNOW
8 BECAUSE 95 PERCENT OF IT I DIDN'T NEED TO WRITE THE
9 APPLICATION.

10 WHATEVER WAS RELEVANT TO PREPARATION OF THE
11 APPLICATION I TOLD HIM.

12 Q ALL RIGHT. WHAT DID YOU TELL MR. WALTER
13 ABOUT THE USE OF THE BIPIN BULBS IN THE MINI-MAGLITE
14 FLASHLIGHT?

15 A I DON'T RECALL TELLING HIM ANYTHING OTHER
16 THAN THAT THE BULB WAS A BIPIN BULB.

17 Q YOU DON'T RECALL?

18 A AS A MATTER OF FACT, I PROBABLY DIDN'T
19 TELL HIM THAT. I GAVE HIM THE HARDWARE AND DRAWINGS
20 AND THEY WERE SHOWN ON THERE.

21 Q AT THE TIME THAT YOU TRANSFERRED THIS
22 INFORMATION TO MR. WALTER, WERE YOU AWARE OF ANY PRIOR
23 USE OF A BIPIN BULB IN ANY FLASHLIGHT OTHER THAN THE
24 MINI-MAGLITE FLASHLIGHT?

25 A I DON'T KNOW, I DON'T RECALL.

1 A I DON'T KNOW WHAT YOU ARE REFERRING TO.

2 Q ON THE FIRST PAGE, IT'S A XEROX OF WHAT
3 APPEARS TO BE THE FILE COVER, IS THIS A FILE THAT WAS
4 PREPARED BY YOUR LAW FIRM OR BY LYON & LYON?

5 A I CAN'T TELL.

6 Q YOU HAVE NO RECOLLECTION?

7 A I HAVE A XEROX COPY WHERE THE TOP LINE IS --
8 SAYS IN VERY -- PURELY ILLEGIBLE, I CAN'T EVEN READ IT.
9 IT'S SHAVED OFF AND SO ONLY PARTIAL -- I CAN'T TELL FROM
10 THIS POOR COPY. IF YOU SHOW ME THE FILE I PROBABLY WOULD
11 BE ABLE TO.

12 Q YOU PROBABLY WOULD BE ABLE TO?

13 A IF YOU SHOW ME THE FILE THAT THIS WAS COPIED
14 FROM WHICH IS NOT ENOUGH INFORMATION ON THE POOR COPY
15 THAT I HAVE TO IDENTIFY IT.

16 Q ON THE -- GOING TO THE FIRST DRAWING WHICH
17 IS K48980, WERE ANY OTHER DRAWINGS GIVEN TO YOU BY
18 MR. MAGLICA?

19 A I DON'T REMEMBER.

20 Q DO YOU REMEMBER WHEN HE GAVE YOU THIS
21 DRAWING?

22 A NO.

23 Q DO YOU REMEMBER APPROXIMATELY?

24 A NO.

25 Q CONCERNING PREPARING THE APPLICATION FOR

1 THIS PATENT 263 PATENT, DO YOU REMEMBER HOW MANY TIMES
2 DID YOU MEET WITH MR. MAGLICA?

3 A I DO NOT REMEMBER.

4 Q YOU DO NOT REMEMBER? WAS IT MORE THAN ONCE?

5 A I DON'T KNOW. IT MAY HAVE BEEN. IT MAY
6 NOT HAVE BEEN.

7 Q TO THE BEST OF YOUR RECOLLECTION, WAS THERE
8 ANYONE ELSE PRESENT WHEN YOU MET WITH MR. MAGLICA?

9 A NO, TO THE BEST OF MY RECOLLECTION THERE
10 WAS NOT.

11 Q DID MR. -- OTHER THAN THE DRAWING THAT WE
12 HAVE IN FRONT OF US, K48980, DID MR. MAGLICA SHOW YOU ANY
13 OTHER DRAWINGS?

14 A I DON'T KNOW.

15 Q DID HE SHOW YOU ANY NOTEBOOKS?

16 A NOT THAT I RECALL.

17 Q DID HE SHOW YOU ANY DRAWINGS THAT WERE NOT
18 DOCUMENTS? IN OTHER WORDS, DESCRIPTIVE DOCUMENTS?

19 A I'M TRYING HARD TO REMEMBER, AND I JUST
20 DON'T REMEMBER BECAUSE I CAN'T DISCERN WHAT HE SHOWED ME
21 IN CONNECTION WITH -- WITHOUT SEEING IT, WHAT HE SHOWED
22 ME IN CONNECTION WITH THIS COMPARED TO WHAT HE SHOWED ME
23 WITH OTHER APPLICATIONS THAT I HANDLED FOR HIM. SO I
24 JUST DON'T KNOW.

25 Q NOW, THIS DOCUMENT WE'RE LOOKING AT, THE

1 WHETHER A FILE IS ACTUALLY MADE UP AND IF SO WHAT
2 HAPPENED TO IT, I DON'T KNOW.

3 Q LET ME REPHRASE IT THIS WAY.

4 DO YOU KNOW IF A FILE WAS EVER MADE UP?

-5 A NO, I DON'T.

6 Q IF A FILE HAD BEEN MADE UP, DO YOU HAVE ANY
7 KNOWLEDGE OF WHETHER IT WAS SUBSEQUENTLY LOST?

8 A I DO NOT HAVE ANY KNOWLEDGE.

9 Q DO YOU HAVE ANY KNOWLEDGE OF WHETHER ANY
10 OF THE PHYSICAL HARDWARE EITHER PARTS OR FLASHLIGHTS
11 THAT MR. MAGLICA GAVE YOU WERE EVER LOST BY ANYONE IN
12 YOUR FIRM?

13 A NO, I HAVE NO REASON TO THINK THAT.

14 Q DO YOU HAVE ANY KNOWLEDGE WHETHER ANY
15 HARDWARE WAS LOST AT ANY APPLICATION ON THE -- APPLICATION
16 FOR DESIGN PATENT NOT BEING PREPARED?

17 A MAY I HEAR THAT QUESTION AGAIN?

18 Q LET ME REPHRASE IT.

19 DO YOU HAVE ANY RECOLLECTION OF ANY
20 HARDWARE BEING LOST THAT AFFECTED WHETHER A DESIGN
21 APPLICATION WAS PREPARED OR NOT?

22 A NO.

23 Q WHEN DID YOU FIRST REALIZE THAT A DESIGN
24 APPLICATION HAD NOT BEEN PREPARED?

25 A THE TROUBLE I HAVE WITH YOUR QUESTION IS IT

1 OF THE WORD THAT IT WAS REQUESTED AND SOMEHOW DID NOT
2 GET DOWN IN THAT SENSE, IT WAS LOST OR DROPPED BETWEEN
3 THE CRACKS, SOMETHING OF THAT NATURE. THAT WOULD BE MY
4 EXPLANATION AS TO WHAT HE MEANT AND BASED ON THE
5 INFORMATION I HAVE NOW, IT'S NOT A BAD CHARACTERIZATION.

6 Q THE DOCUMENT OR DOCUMENTS WHICH MR. MAGLICA
7 BROUGHT TO YOU TO PREPARE THE APPLICATION, WHERE WOULD
8 THEY BE NOW?

9 A THE DOCUMENTS THAT HE BROUGHT TO ME TO BE
10 PREPARED?

11 Q YES.

12 A TO USE IN PREPARING THE APPLICATION?

13 Q RIGHT.

14 A I WOULD GUESS THEY'RE IN THE FILES THAT
15 WERE SENT TO LYON & LYON AND THAT ARE REFLECTED IN PART
16 IN THE COPIES THAT YOU GAVE ME.

17 Q SO SHOULD ALL THOSE DOCUMENTS BE IN THOSE
18 FILES?

19 A EVERYTHING THAT I HAD I SENT DOWN THERE
20 WITH THE EXCEPTION OF THE FEW MISCELLANEOUS DOCUMENTS,
21 NONE OF WHICH SEEMED TO RELATE TO THE APPLICATION THAT
22 I TALKED ABOUT FIRST THING THIS MORNING.

23 Q NOW, CONCERNING THE HARDWARE THAT HE
24 BROUGHT, WHERE DID THAT GO?

25 A I DON'T KNOW. I DON'T KNOW IF THAT WAS

1 SENT DOWN OR NOT. IT'S POSSIBLE THAT I OVERLOOKED THAT
2 AND STILL HAVE IT SOMEWHERE OR IT'S POSSIBLE THAT IT WAS
3 THROWN OUT WITH OTHER OLD -- OLD IN THE SENSE OF BEING
4 UNIMPORTANT FOR ANY REASON THAT -- I'M TALKING ABOUT
-5 HARDWARE THAT IS USED TO PREPARE APPLICATIONS. AFTER THE
6 APPLICATIONS ARE PREPARED, THEY'RE STORED FOR A WHILE
7 AND EVENTUALLY THROWN OUT.

8 I DON'T KNOW IF IT WAS THROWN OUT, WE SENT
9 IT TO LYON & LYON OR I STILL HAVE IT.

10 Q WOULD IT BE MUCH TROUBLE TO CHECK?

11 A NO, IT WOULD NOT. I WILL CHECK.

12 Q THANK YOU.

13 A IF I HAVE IT, HOW WILL IT BE -- I WILL
14 GIVE IT TO MR. WEISS AND LET YOU DEAL WITH IT THAT WAY.

15 MR. DINAN: TURN IT OVER TO MR. WEISS AND MR. WEISS,
16 IF HE DOES, IN FACT, GIVE YOU THAT, YOU WILL INFORM
17 COUNSEL?

18 MR. WEISS: YES.

19 MR. DINAN: THEN WE CAN GO FROM THERE.

20 Q NOW, IN THE PREPARATION OF THE 263 PATENT,
21 IT HAS FOR THE IDENTIFICATION OF THE INVENTOR ANTHONY
22 MAGLICA ONTARIO, CALIFORNIA.

23 WHY WAS THE INVENTORY PUT ANTHONY MAGLICA?

24 A WHAT ARE YOU ASKING ME?

25 Q WELL, I'M REALLY ASKING THIS QUESTION AS A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	Group Art Unit: 291
ANTHONY MAGLICA)	Examiner: M. Tung
Serial No. 07/410,965)	
Filed: September 22, 1989)	
For: FLASHLIGHT)	Los Angeles, CA 90017

DECLARATION OF MARTIN J. SIEGEL
PURSUANT TO 37 C.F.R. 1.196(b)(1)

September 29, 1992

Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

I, Martin J. Siegel, hereby declare and state as follows:

1. I am a Consulting Engineer specializing in mechanical and metallurgical matters, and my offices are at 743 Schumacher Drive, Los Angeles, California 90048.
2. I have a Bachelor of Science degree in Mechanical Engineering from the City College of New York, and a Master of Science degree in Metallurgical Engineering from the University of Cincinnati. I have also pursued graduate work in applied mechanics, and material and manufacturing processes.
3. I have been in the practice of Mechanical Engineering since 1944 and have been a licensed Professional

Ex. F

Engineer in the State of New York since 1953 and in the State of California since 1956. I have maintained a Consulting Engineering practice since 1953.

4. I was a Professor of Mechanical Engineering at the University of Southern California from 1955 to 1988 at which I am still a Professor Emeritus of Mechanical Engineering. Furthermore, I have made several publications in the field of mechanical design and am a member of various professional societies pertaining to Mechanical Engineering.

5. My engineering practice and teaching have been primarily in the field of Mechanical Design, and have included the preparation and interpretation of drawings and specifications for production of parts on various machines.

6. As a consultant and teacher I have personally made numerous assembly and detail drawings of machine parts and directed the preparation of such drawings by draftsmen and students. Furthermore, I have been called upon on numerous occasions to interpret drawings prior to and during production, and to prepare drawings for illustration. As such, I am familiar with such drawing techniques and practice.

7. Based on my experience in the mechanical design field set forth above, I believe I am qualified to give opinions which are pertinent to the flashlights drawings I have reviewed in this case. Specifically, I believe I am qualified to give

opinions regarding a comparison of the drawings of the original utility application, U.S. Patent Application Serial No. 638,042, which are attached hereto as Exhibit A, with the drawings of the present design application, U.S. Design Patent Application Serial No. 410,965, which are attached hereto as Exhibit B.

8. I have specifically examined the profile of the head of the flashlight shown in Figure 2 of the drawings of the original utility application and I have compared it with the head shape shown in drawings of the present design application. For purposes of comparing the two, I prepared and examined enlargements of upper and lower segments of the head profile as shown in Figure 2 of the original utility application and in the drawings of the current design application. The copies were enlarged approximately ten (10) times. The enlarged copies of the upper section are attached hereto as Exhibit C and the enlarged copies of the lower section are attached as Exhibit D.

9. After comparing the head shape as shown in the normal-sized drawings as well as in the enlarged upper and lower segments mentioned above, it is clear that the profile of the flashlight head shown in Figure 2 of the original utility drawings includes a curved portion and that the profile of the flashlight head as shown in Figure 2 is not defined by the intersection of two straight lines. Furthermore, a comparison of the above drawings shows that the head shape of the flashlight in

Figure 2 of the original utility application is the same as the head shape of the flashlight shown in the drawings of the current design application.

10. Because the profile of the flashlight head in Figure 2 of the drawings of the original utility application includes a curved portion, and because the profile of the flashlight head shown in Figure 2 is not defined by the intersection of two straight lines, it would be incorrect to show a parting line on the surface of the flashlight head in the drawings of the current design application based on Figure 2 of the drawings of the original utility application.

11. In addition to Figure 2 of the drawings of the original utility application, I have also examined Figures 1 and 3 of these drawings. After comparing the flashlight head shown in Figure 1 to that shown in Figures 2 and 3, it is my opinion that the shape of the flashlight head shown in Figure 1 is inconsistent with that shown in Figures 2 and 3. That is, Figures 2 and 3 clearly show the flashlight head to include a curved portion while Figure 1 does not. It is my opinion that a person having ordinary skill in interpreting design drawings would recognize this inconsistency.

12. Attached hereto as Exhibit E is an enlarged copy of the upper segment of the profile of the flashlight head shown in Figure 2 of the original utility application. Also included

in Exhibit E is an enlarged copy of the same segment with the existing curved line deleted and replaced with two straight, intersecting lines. Both copies were enlarged approximately twelve (12) times. The modified drawing depicts a section view of Figure 1 with two intersecting straight lines. The inconsistency referred to in the preceding paragraph is shown by the modified drawing.

13. I have also examined the tail cap as shown in Figures 1, 2 and 8 of the drawings of the original utility application which partially show the planar back face of the tail cap. I have also examined the tail cap in unamended Figures 3 and 6 of the current design application. The flashlight shown in original utility application Figures 1, 2 and 8 is symmetrical in nature. Based on this symmetry, it would be expected that the planar back face of the tail cap as partially shown in Figure 2 of the drawings of the original utility application would extend throughout the region of the tail cap shown in unamended Figure 6 of the current design application.

14. Because of the symmetry of the flashlight shown in the original utility application Figures 1, 2 and 8 and how design drawings are normally interpreted, it would be expected that the shapes designated A13 and A14 therein would be the same on the other side of tab 29 as they are shown in unamended Figures 3 and 6 of the current design application.

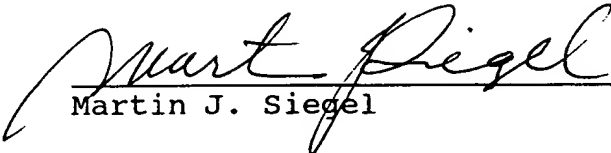
15. In connection with my examination of the flashlight head shown in Figure 2 of the drawings of the original utility application, I noted the indentations located at the top and bottom of the profile of the flashlight head designated A16 in Exhibit A. These indentations in this section view together with Figure 8 of the original utility application would be interpreted as a band extending around the head which represents some form of knurling on the surface of the flashlight head.

16. In connection with my examination of Figures 1 and 8 of the original utility application, I noted the cross-hatching pattern depicted on the flashlight barrel. This cross-hatching pattern would be interpreted as a form of knurling on the flashlight barrel.

I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. I also declare further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001 and that

such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Executed at Los Angeles, California, on this 29 day
of September, 1992.



Martin J. Siegel

TSM/gcp/2542/a:siegel.dec

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☒ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☒ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☒ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.